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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/381,334	11/18/1999	KARI VIRTANEN	PM264014	3837
909	7590	08/04/2006	EXAMINER	
PILLSBURY WINTHROP SHAW PITTMAN, LLP			IQBAL, KHAWAR	
P.O. BOX 10500			ART UNIT	
MCLEAN, VA 22102			PAPER NUMBER	
			2617	

DATE MAILED: 08/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/381,334	VIRTANEN, KARI	
	Examiner	Art Unit	
	Khawar Iqbal	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6-23-06 has been entered.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 2 and 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter i.e., accessing the mobile subscriber via the first and the second network, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For example, claim 1 recites the limitation "the mobile subscriber data comprising address information for accessing the mobile subscriber via the first and the second network" on page 2, lines 7 and 8. It is not clear from the original specification how address information is being used to access the mobile

subscriber via the first and the second network. One of ordinary skill in the art would not be able to establish the claimed "accessing" without undue experimentation.

3. Claims 2 and 8 are rejected for the same reasons as discussed above with respect to claim 1.

4. Claims 1, 2, and 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim 1, recites the phrase 'subscriber-specific operator'. There does not appear to be a written description of meaning of the phrase in the application as originally filed.

5. Claims 2 and 8 are rejected for the same reasons as discussed above with respect to claim 1.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-13 are rejected under 35 U.S.C. 102(e) as being unpatentable by Nordman (6061346).

8. Regarding claim 1 Nordman teaches a method of registration in a telecommunications system by a mobile station, which system comprises a home location register for maintaining subscriber data and supports a first network, and a second network, the method comprising: (figs. 1-4):

maintaining the mobile subscriber data in the home location register, and sending, from another network element, a message to the home location register for requesting the mobile subscriber data, comprising address information for accessing the mobile subscriber via the first network and second network (col.7, lines 36-67, col.8, line 50-col. 9 line 30),

the home location register maintaining a subscriber-specific access parameter which indicates, independently of the address information, whether the mobile subscriber is entitled to use the first network, the second network or both networks (col.7, lines 36-67, col.8, line 50-col. 9 line 30);

wherein the first network and second network are provided by common operator(col.7, lines 36-67, col.8, line 50-col. 9 line 30);

in response to said message for requesting the subscriber data, the home location register sending the mobile subscriber data and also said subscriber-specific access parameter (col.7, lines 36-67, col.8, line 50-col. 9 line 30);

the network element that requested the mobile subscriber data using said access parameter for restricting the access of the mobile subscriber only to the first network or to the second network (col.7, lines 36-67, col.8, line 50-col. 9 line 30).

Regarding claim 2 Nordman teaches a method of registration in a telecommunications system by a mobile station, which system comprises home location register for maintaining subscriber data and supports a first network, and a second network, (figs. 1-4) the method comprising:

Storing, in the memory of a mobile station, mobile subscriber data comprising address information for accessing the mobile subscriber via the first and second network (col.7, lines 36-67, col.8, line 50-col. 9 line 30, col. 6, lines 4-27);

Storing, in the memory of a mobile station, a subscriber-specific access parameter indicating whether the mobile subscriber is entitled to use the first network, the second network or both networks (col.7, lines 36-67, col.8, line 50-col. 9 line 30, col. 6, lines 4-27); and

wherein the first network and second network are provided by common operator(col.7, lines 36-67, col.8, line 50-col. 9 line 30);

the mobile station using said access parameter to restrict the access of the mobile subscriber only to the first and/or the second network (col.7, lines 36-67, col.8, line 50-col. 9 line 30, col. 6, lines 4-27).

Regarding claim 3 Nordman teaches the mobile subscriber's access can be restricted only to one network even though a short message service had been defined for the mobile subscriber (col.7, lines 36-67, col.8, line 50-col. 9 line 30, col. 6, lines 4-27).

Regarding claims 4-6 Nordman teach wherein the network element that requested the mobile subscriber data uses said access parameter to prevent location

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updating in a network which the mobile subscriber is not entitled to use (col.7, lines 36-67, col.8, line 50-col. 9 line 30, col. 6, lines 4-27).

Regarding **claims** 7,11,13 Nordman teach first network is a circuit-switch and second is packet-switched (col.7, lines 36-67, col.8, line 50-col. 9 line 30, col. 6, lines 4-27).

Regarding claim 8 Nordman teaches a data structure embodied in a tangible, comprises (figs. 1-4)

mobile subscriber data in a telecommunications system which supports a first and a second network the mobile subscriber data comprising address information for accessing the mobile subscriber via the first and second network (col.7, lines 36-67, col.8, line 50-col. 9 line 30, col. 6, lines 4-27);

wherein the first network and second network are provided by common operator(col.7, lines 36-67, col.8, line 50-col. 9 line 30);

a subscriber-specific access parameter which indicates, independently of address information whether the mobile subscriber is entitled to use the first network, the second network or both networks (col.7, lines 36-67, col.8, line 50-col. 9 line 30, col. 6, lines 4-27).

Regarding claim 9 Nordman teaches wherein the data structure is located in a home location register of the telecommunications system (col.7, lines 36-67, col.8, line 50-col. 9 line 30, col. 6, lines 4-27).

Regarding claim 10 Nordman teaches wherein the data structure is located in the memory of the mobile station (col.7, lines 36-67, col.8, line 50-col. 9 line 30, col. 6, lines 4-27).

Regarding claim 12 Nordman teaches wherein the data structure is located Subscriber Identity Module of the mobile station (col.7, lines 36-67, col.8, line 50-col. 9 line 30, col. 6, lines 4-27).

Claims 1-8 are rejected under 35 U.S.C. 102(e) as being unpatentable by Salin et al (6370390).

9. Regarding claims 1-3, 8 Salin et al teaches a method of registration in a telecommunications system by a mobile station, which system comprises a home location register for maintaining subscriber data and supports a first network, and a second network, the method comprising: (figs. 1-6):

maintaining the mobile subscriber data in the home location register, and sending, from another network element, a message to the home location register for requesting the mobile subscriber data, comprising address information for accessing the mobile subscriber via the first network and second network (col.17, line 16-col. 18, line 55, col. 10, lines 15-65),

the home location register maintaining a subscriber-specific access parameter which indicates, independently of the address information, whether the mobile subscriber is entitled to use the first network, the second network or both networks (col.17, line 16-col. 18, line 55, col. 10, lines 15-65, figs, 1-6);

wherein the first network and second network are provided by common operator (col.17, line 16-col. 18, line 55, col. 10, lines 15-65);

in response to said message for requesting the subscriber data, the home location register sending the mobile subscriber data and also said subscriber-specific access parameter (col.17, line 16-col. 18, line 55, col. 10, lines 15-65);

the network element that requested the mobile subscriber data using said access parameter for restricting the access of the mobile subscriber only to the first network or to the second network (col.17, line 16-col. 18, line 55, col. 10, lines 15-65, see above).

Regarding claims 3-7 Salin et al teaches the mobile subscriber's access can be restricted only to one network even though a short message service had been defined for the mobile subscriber (col.17, line 16-col. 18, line 55, col. 10, lines 15-65).

Claims 9-13 are rejected for the same reasons as discussed above with respect to claim 1.

Response to Arguments

10. Applicant's arguments filed 06-23-06 have been fully considered but they are not persuasive. The examiner has thoroughly reviewed applicant's arguments but firmly believes that the cited references reasonably and properly meet the claimed limitations. In regard to applicant's arguments against Nordman, Nordman teaches subscriber-specific access parameter is maintained in the remote communication station 12 in its SIM card 18 (subscriber identity module) and wireless host 32. The SIM card 18 includes a storage location 24 for storing authentication information, in conventional manner. The SIM card 18 further includes a storage location 26 for storing the address of the

private IP network 14. In one embodiment of the present invention, the SIM card further includes a storage location 28 for storing a WHI (Wireless Host Identifier). Other subscriber data can additionally be stored at other storage locations of the SIM card 18.

"As the wireless host accessing the GSM network is authenticated prior to receiving permission to use the WHI stored thereat, no separate log-in is needed to access the private IP network 14" (Col. 10, lines 27-32). Nordman teaches a communication system that permits the communication of data between a remote communication station and a private IP network, GSM system (the mobile terminal 16 generates a "PDP routing context activation request" to the SGSN 82 or an access to the MSC/VLR 66, as appropriate. The access to the MSC/VLR 66 is performed, for instance, by placing a call originated at the mobile terminal), wherein when the remote communication station is permitted access to the private IP network, data can be communicated between the remote communication station and the private IP network (Col. 5, lines 41-47). The communication system is a form of a GSM cellular communication system of which the network infrastructure forms a wireless access network to which the private IP network is coupled (Col. 5, lines 59-64). The communication system includes a radio transceiver, which includes a subscriber identity module (SIM) card, which is inserted into, or is otherwise connected, to the radio transceiver. Col. 5, line 66 - Col. 6, line 3. The SIM card includes a storage location for storing authentication information in conventional manner and a storage location for storing the address of the private IP network. In one embodiment, the SIM card includes host identifier and other subscriber data can a storage location for storing a wireless additionally is stored at other storage locations of

the SIM card. Col. 6, lines 4-11. The system includes a base transceiver station, which is coupled through a base station controller to a mobile switching center. Col. 6, lines 29-54. The mobile switching center is coupled to a home location register, which includes an authentication center at which an international mobile subscriber identity (IMSI) pseudo-random number are stored and a value of a Col. 6, lines 55-60. A value of the wireless host identifier and an address associated with the private IP network is also stored at the home location register. Col. 6, lines 63-67. During operation when an operator of the wireless host desires access to the private IP network, appropriate commands are generated at the wireless host to initiate a request for access to the private IP network (Col. 7, lines 26-30). Signals indicative of such request are provided to the mobile terminal and the mobile terminal generates a request over the air interface as an uplink wireless host identifier signal communicated to the base terminal station. An attached procedure is initiated and the base terminal station forwards the request through the base station controller to the mobile switching center (Col. 7, lines 30-36). The IMSI and pseudo-random number are retrieved from the home location register and an authentication procedure is carried out (Col. 7, lines 36-38). Details of the authentication procedure carried out in a GSM communication system can be found in the specification standards of the GSM system. In general, the authentication procedure authenticates, i.e., confirms, that the mobile terminal is permitted to communicate by way of the network infrastructure forming the wireless access network. Once the authentication procedure is successfully completed, a value of the wireless host

identifier associated with the wireless host is forwarded to the private IP network (Col. 7, lines 36-50).

Conclusion


Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Khawar Iqbal whose telephone number is (571) 272-7909.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Joseph H. Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

Khawar Iqbal


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER